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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/501,676

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Terje Skaug

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EXAMINER

KARIM L PEGEMAN

ART UNIT

PAPER NUMBER

2629

MAIL DATE

DELIVERY MODE

01/05/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/501,676

Applicant(s)

SKAUG, TERJE

Examiner

PEGEMAN KARIMI

Art Unit

2629

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed on 11/26/2008 has been entered and considered by the examiner.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyashita (U.S. Patent No. 6,909,906) in view of Steele (U.S Patent No. 6,201,534).

As to claim 1, Miyashita teaches an apparatus (100), comprising:

an already existing electronic device having a screen display (the existing electronic device has a display screen 101), and

one or more pointing device components integrated into the already existing electronic device (the pointing device 105 is added to the existing electronic device 100),

wherein said one or more pointing device components are configured to give the already existing electronic device, in addition to its main functions (the already existing electronic devices main function is a mobile telephone, col. 5 lines 2-7),

an auxiliary function as a pointing device (the auxiliary function is the mouse functionality of 105, col. 5, lines 8-11),

Miyashita does not mention the already existing electronic device to act together with an external electronic screen device. Steele teaches the already existing electronic device (400a) to act together with an external electronic screen device (416a), which makes use of the pointing device (108a), (col. 6, lines 48-49). and wherein the external electronic screen device is other than the screen display of the already existing electronic device. (the screen 101 on Miyashita's is different than the screen 416a in Steele because one is attached to the already existing electronic device and the other is not attached to the already existing electronic device and is considered an external display screen). Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to have added the remote control system 400a of Steele to the telephone set main body of Miyashita which will result in a useful and tangible result, wherein the user can use the same device for multiple usage such as a telephone and a cursor positioning device to select an item on the view screen.

As to claim 2, Miyashita does not mention an optical or radio transmission connection with the external electronic device. Steele teaches the already existing electronic device (400a) comprises optical or radio transmission means configured to establish a wireless connection with the external electronic screen device (col. 6, lines 53-56), (the remote control and external screen are connected with an infrared signal).

As to claim 3, Steele the pointing device (400a) components comprise at least one of the following components:

a mechanical or optical reader, a button element and a scroll wheel (108a and 106a).

As to claim 4, Miyashita teaches the pointing device components (109, 107, and 108) are integrated in an auxiliary unit (105), said auxiliary unit is releasably mounted to the already existing electronic device (as can be seen in Fig. 2 the auxiliary unit is releasable from the already existing electronic device 100 by portions 125 and 126, col. 7, lines 5-9) in such a manner that the auxiliary unit can be released and act as a-the pointing device separately from the already existing electronic device (as can be seen in Fig. 2 the auxiliary unit 105 is separated from the already existing electronic device 100 and is used as a mouse).

As to claim 5, Steele teaches the auxiliary unit further comprises optical or radio transmission means (infrared connection), said optical or radio transmission means is configured to establish a wireless connection with the external electronic screen device (col. 6, lines 53-56), (the remote control and external screen are connected with an infrared signal).

As to claim 6, Miyashita teaches the auxiliary unit is a battery pack of the already existing electronic device (col. 6, lines 9-12).

As to claim 10, Miyashita teaches the already existing electronic device (100) is one of the following devices: a mobile telephone, a personal data assistant (PDA), a digital audio player and a minidisk player (device 100 is a mobile telephone).

As to claim 11, Steele teaches the pointing device (400a) components comprise at least one of the following components:

a mechanical or optical reader, a button element and a scroll wheel (108a and 106a).

As to claim 12, Miyashita teaches the pointing device components (109, 108, and 107) are configured in a body of the already existing electronic device (the components 107-109 are configured in the already existing electronic device 100 via 105) in such a manner that the body is suitable for contact with a user's palm (It can be seen in Fig. 1 that the mobile telephone device is used by a user and requires a user to use the telephone with his/her hand).

As to claim 13, Miyashita teaches the pointing device components (107-109) are configured to perform functionality of a mouse unit (col. 6, lines 8-11).

As to claim 14, Miyashita teaches the pointing device components (107-109) are configured in a body of the already existing electronic device (the components are configured in the already existing electronic device 100 via 105) in such a manner that

the body appears to a user like a body of a mouse unit (the body 105 configured in the already existing electronic device 100 is a mouse having left and right buttons 107 and 108 and rotary wheel 109).

Response to Arguments

4. Applicant's arguments with respect to claims 1-6 and 10-14 have been considered but are moot in view of the new ground(s) of rejection.

The new reference of Steele (U.S Patent No. 6,201,534) is added to read better on the newly added limitations in the claims 1-6 and 10-14.

Applicant argues that the reference of Bowers does not specify that "the one or more pointing device components are configured to give the already existing electronic device, in addition to its main function, an auxiliary function as a pointing device, thus ...". The reference of Bowers is dropped from the consideration and a new reference of Steele is added.

Applicant argues that Miyashita is unable to be used with the external electronic screen device as the pointing device. The newly added reference of Steele in combination with Miyashita results in a useful and tangible result.

The reference of Steele teaches a remote control system 400a, which has a scroll wheel 108a similar to the rotary wheel 109 of auxiliary device 105 of Miyashita. In Steele the remote control system 400a can control a display 416a, which is an external display, one ordinary skilled in the art at the time the invention was made can combine the remote control system 400a of Steele with the functionality of the operation

unit 105 in the mobile telephone 100 of Miyashita so that the user can use the same device for multiple usage such as a telephone and a cursor positioning device to select an item on the view screen instead of two devices.

Based on the above combination of the two references of Steele with Miyashita the combination would read on the limitations of claims 1-6 and 10-14.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Revis (U.S. Patent No. 6,285,354) teaches a combination of mouse and telephone handset.

Blood (U.S. Patent No. 6,694,391) teaches a combination of mouse and telephone handset.

Yeom (U.S. Patent No. 5,943,625) teaches a dual propose telephone and mouse.

Inquiry

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PEGEMAN KARIMI whose telephone number is (571)270-1712. The examiner can normally be reached on Monday-Thursday 8:00am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on (571) 272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pegeman Karimi/
Examiner, Art Unit 2629
January 1, 2009

/Chanh Nguyen/
Supervisory Patent Examiner, Art
Unit 2629